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| 10/725,051 | 12/01/2003 | Clarence Thibeau | 501-28 | 2968 |
| 23117 | 7590 | 09/27/2007 | EXAMINER | |
| NIXON & VANDERHYE, PC | | | LAUX, JESSICA L | |
| 901 NORTH GLEBE ROAD, 11TH FLOOR | | | ART UNIT | PAPER NUMBER |
| ARLINGTON, VA 22203 | | | 3635 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/725,051 | THIBEAU, CLARENCE | |
| | Examiner | Art Unit | |
| | Jessica Laux | 3635 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 July 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,12-14,16 and 19-22 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4,7-11,15,17,18 and 23-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 07/25/2007 have been fully considered but they are not persuasive.

Applicant argues that Duragrid does not disclose that the "soft tile" can be used as an air gap spacer. Examiner notes that there are no limitations of the claim or disclosure in the specification distinguishing applicant's invention from the prior art that would indicate that the device as disclosed in Duragrid would not be capable of being used as an air gap spacer. Furthermore, in as much as applicant's invention is capable the claimed use so is the device of Duragrid. Examiner additionally notes that one of ordinary skill in the art would be motivated to look to the Duragrid device as it solves the same problem of providing a spacing on a water prone surface for drainage.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the building codes prohibiting more than 20% of a wall area be covered and the three typical building code requirements) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding applicants arguments to the rejection of claim 15, examiner maintains that the aperture (page 3, element A) is fully capable of being secured by tacks, nails

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and screws regardless of its intended purpose. As long as the feature is capable of the claimed function the claim limitations are anticipated.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites possible shapes of a cuboid or a rectangular block with directly conflict with the claim 1 limitation of a base and an apex having a lesser width than the base.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1, 23, 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite the limitations of "the thickness of the planar surfaces is of a size so as to prevent trapping water and moisture". There is no disclosure indicating that the thickness of the planar surface would in any way be designed to prevent trapping water.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-11, 15, 17-18, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

<http://web.archive.org/web/20010202015800/http://duragrid.com/>.

Regarding claims 1-4, 7-10, 17, 24: Duragrid discloses a spacer capable of providing spacing between an outer wall surface of a building under construction and an exterior cladding material, wherein the exterior cladding material is one of: siding, shingles, brick and clapboard, the spacer comprising:

a planar surface comprising a plurality of interconnected matter surface areas and a plurality of diamond, square, rectangular or quadrilateral apertures, in a repeating lattice-like pattern, between the matter surface areas, the apertures aggregately comprising a greater portion of the planar surface's total area than the matter surface areas aggregately comprise (page 5, figures 1-4c); and

a plurality of mutually spaced protrusions of substantially uniform height protruding perpendicularly, in a repeating pattern, to form a protrusion plane parallel to the planar surface, from only one side of said matter surface areas, the apexes of at least some of said protrusions forming a protrusion plane, a second side of the matter

surface areas opposite the first side of the matter surface areas having portions opposite the protrusions' bases that are un-apertured (page 3, figure 1); whereby, when the spacer is in place between the outer wall surface of the building and the exterior cladding material, liquid and air may pass through channels formed between the protrusions, and not through the protrusions, to facilitate air circulation in, and liquid drainage from, the spacing between the outer wall surface and the exterior cladding material, and

wherein the thickness of the planar surfaces and the ratio of the matter surface areas to the aperture areas are of sizes so as to prevent trapping water and moisture in horizontal spaces defined by the matter surface areas when the air gap spacer is mounted between the outer wall surface of the building and the exterior cladding material (page 3, figure 1).

Duragrid does not disclose that the protrusions have a base of a first width and an apex of the second, lesser, width, nor that the protrusions are selected from a shape of the group consisting of: pyramidal, flat topped pyramidal, conical, flat topped conical, rectangular based pyramid, cuboid and rectangular block. Rather, Duragrid discloses that the protrusions are cylindrical in shape. Applicant has not disclosed that the claimed shapes provide an advantage, solve a stated problem, or are for a particular purpose; instead on page 11, line 28, applicant discloses that many other shapes could be used. It appears to be a mere matter of design choice, that would have been obvious to one of ordinary skill in the art, to have protrusions of any shape as such a feature does not appear to be a critical design feature. Further it appears that any

shape would perform the same function of spacing the device from the wall while allowing drainage equally well. Therefore it would have been obvious to modify the cylindrical protrusion of Duragrid to be of a conical (or other shape) as these shapes are commonly known and used in the art for protrusions of air gap spacers and they provide for more water flow therebetween.

Regarding claim 15: The air gap spacer according to claim 1 above, wherein the air gap spacer is adapted to be secured to the surface of the building being constructed by way of securing means selected from the group consisting of tacks, nails and screws (where the spacer has apertures (page 3, element A) that are adapted to be secured to a building with tacks, nails, or screws).

Regarding claim 23: Duragrid discloses an air gap spacer, capable of providing spacing between an outer wall surface of a building under construction and an exterior cladding material, the air gap spacer comprising:

a planar surface (capable of attachment to an exterior sheathing or wrap over the outer wall surface prior to the exterior cladding material being attached), the planar surface being comprised of a plurality of matter surface areas interconnected in a lattice-like pattern and a plurality of apertures between the matter surface areas, the apertures aggregate comprising a greater portion of the surface's total area than the matter surface areas (page 5, figures 1-4c); and

a plurality of mutually spaced protrusions of substantially uniform height protruding from only one side of said matter surface areas, the apices of at least some of said protrusions forming a protrusion plane (where the apices are all of the same

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height and therefore end in the same plane) for abutment to the outer wall surface of the building, where portions of the matter surface areas corresponding to the protrusions' bases being un-apertured on another side of the matter surface areas opposite the protrusions (page 3, figure 1);

whereby, when the spacer is in place, liquid and air may pass through channels formed between the protrusions, and not through the protrusions, to facilitate air circulation in, and liquid drainage from, the spacing between the outer wall surface and the exterior cladding material; and

wherein the thickness of the planar surfaces and the ratio of the matter surface areas to the aperture areas are of sizes so as to prevent trapping water and moisture in horizontal spaces defined by the matter surface areas when the air gap spacer is mounted between the outer wall surface of the building and the exterior cladding material (page 3, figure 1).

Duragrid does not disclose that the protrusions have a base of a first width and an apex of the second, lesser, width, nor that the protrusions are selected from a shape of the group consisting of: pyramidal, flat topped pyramidal, conical, flat topped conical, rectangular based pyramid, cuboid and rectangular block. Rather, Duragrid discloses that the protrusions are cylindrical in shape. Applicant has not disclosed that the claimed shapes provide an advantage, solve a stated problem, or are for a particular purpose; instead on page 11, line 28, applicant discloses that many other shapes could be used. It appears to be a mere matter of design choice, that would have been obvious to one of ordinary skill in the art, to have protrusions of any shape as such a

feature does not appear to be a critical design feature. Further it appears that any shape would perform the same function of spacing the device from the wall while allowing drainage equally well. Therefore it would have been obvious to modify the cylindrical protrusion of Duragrid to be of a conical (or other shape) as these shapes are commonly known and used in the art for protrusions of air gap spacers and they provide for more water flow therebetween.

Regarding claims 11 and 18: Duragrid discloses the spacer as in the above claims, but does not expressly disclose the material the spacer is made of. However it appears from the disclosure of Duragrid that the spacer is made of a plastic material. Further applicant has disclosed various types of materials suitable for the spacer and has not disclosed that the claimed materials provide and advantage, solve a problem or are for a particular purpose. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the disclosure of Duragrid to make the spacer of plastic for its ease in manufacture and water resistance characteristics.

Additionally it should be noted that claim 11 is considered a product-by-process claim. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). In this

case the spacer of Duragrid appears to be made of plastic and injection moulding, and pouring moulding are obvious methods of producing a plastic product.

**Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over
<http://web.archive.org/web/20010202015800/http://duragrid.com/> in view of US
Publications 20010054263 or 20030126810.**

Regarding claim 25: Duragrid discloses the air gap spacer of claim 25 as indicated above. The limitations of "providing" and "placing" the disclosed spacer are merely obvious method steps, that are notoriously well known in the art, for installing an air gap spacer and as such are not patentable over the prior art; reference 20010054263, 20030126810 which both disclose a drainage mat placed between an outer wall surface of the a building and an exterior cladding material.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 6:30am to 2:30pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


/JEANETTE CHAPMAN/
PRIMARY EXAMINER
ART UNIT 3635

JL
09/17/2007